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UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte BRUCE BAKER

Appeal 2008-4191
Application 10/821,766
Technology Center 1700

Decided: October 28, 2008

Before TONI R. SCHEINER, DEMETRA J. MILLS, and JEFFREY N.
FREDMAN, *Administrative Patent Judges*.

FREDMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a hand tool which the Examiner has rejected on the grounds of anticipation and obviousness. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

Background

“Most lawn and garden implements, including shovels, rakes, trowels, and so forth, use conventional, straight handles because they are easily manufactured” (Spec. 1:6-7). The Specification teaches that “Straight handles are not energy efficient, however, because the user must grip the handle to prevent it from sliding in the user's hands. . . . Angled handles try to take advantage of a user's body shape and position the arm, wrist, hand and torso in a more relaxed posture” (Spec. 1:7-13).

Statement of the Case

The Claims

Claims 20-25, 30 and 31 are on appeal. We will focus on claims 20, 22, 24, 30 and 31, which are representative and read as follows:

- 20. A hand tool, comprising:
 - a curved trowel blade having a lower surface tangent to a plane;
 - a handle attached to the blade, the handle being curved in a plane perpendicular to the plane tangent to the blade;
 - the handle including an outer surface defining a portion of a circular arc; and
 - wherein the handle terminates in a gripping section that intersects and extends beyond the plane tangent to the blade.
- 22. The hand tool of claim 20, wherein the circular arc has a radius on the order of 3 to 4 inches.
- 24. The hand tool of claim 20, wherein the gripping section includes a slight taper along its length.

30. The hand tool of claim 20, wherein the handle includes a polymeric covering.

31. The hand tool of claim 20, wherein:
the blade defines a primary line of attack; and
the gripping section allows a user to hold the tool in a wrist-neutral position with a user's forearm aligned along the line of attack

The prior art

The Examiner relies on the following prior art reference to show unpatentability:

Jasperson	Des. 305,496	Jan. 16, 1990
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The issues

The rejections as presented by the Examiner are as follows:

- A. Claims 20, 21, and 31 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Jasperson (Ans. 3).
- B. Claims 22-25 and 30 stand rejected under 35 U.S.C. § 103(a) as being obvious over Jasperson (Ans. 4-6).

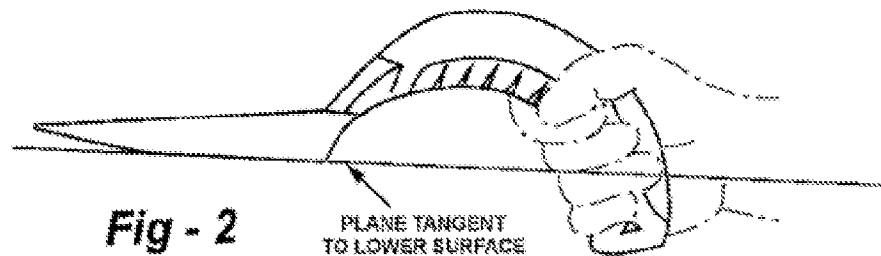
A. 35 U.S.C. § 102(b) rejection over Jasperson

The Examiner¹ argues that Jasperson teaches a curved trowel blade having a lower surface tangent to a plane; a handle attached to the blade, the handle being curved in a plane perpendicular to the plane tangent to the blade; the handle including an outer surface defining a portion of a circular arc; and wherein the handle terminates in a gripping section that intersects and extends beyond the plane tangent to the blade.

¹ We refer to the Examiner's Answer mailed August 21, 2007.

(Ans. 3-4). The Examiner further contends regarding the tangent limitation that “Applicant's claim language is to such a broad extent that the applied art could clearly meet such limitations since no limiting language has been claimed to prevent such an interpretation” (Ans. 6).

Appellant² argues that “[t]o illustrate the limitation of ‘a lower surface tangent to a plane and a handle that terminates in a gripping section that intersects and extends beyond the plane tangent to the blade,’” Appellant draws a line as follows” (App. Br. 3). Appellant’s drawing is reproduced below:



Appellant’s drawing shows a trowel with a curved handle with a plane tangent to a lower surface which intersects the handle (App. Br. 3).

Appellant contends that this drawing “is the only *reasonable* interpretation of this limitation” (App. Br. 3). Appellant argues that the interpretation of the Examiner “is arbitrary and contrary to common sense” (App. Br. 4). Appellant further argues that “if the Examiner had simply used another Figure of Jasperson - Figure 5, for example - the handle never comes near a plane tangent to the ‘lower surface’” (App. Br. 4).

² We refer to the Appeal Brief filed May 9, 2007.

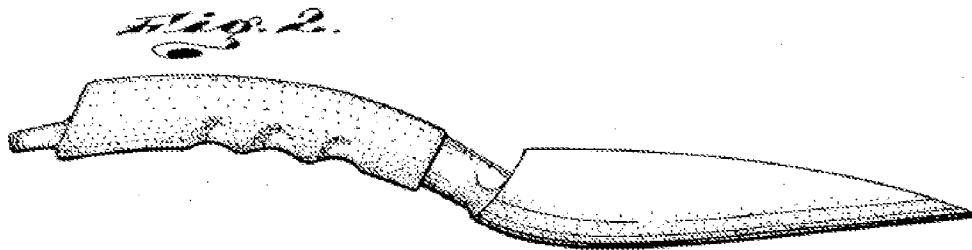
Appellant further argues that “[t]o be consistent, the Examiner must be able to draw his proposed line on *every view* of the cited reference. This is impossible because the Examiner's interpretation of Appellant's claim language is unorthodox” (App. Br. 5).

In view of these conflicting positions, we frame the anticipation issue before us as follows:

Does the trowel of Jasperson have a lower surface of a trowel blade tangent to a plane, wherein the handle terminates in a gripping section that intersects and extends beyond the plane tangent to the blade?

Findings of Fact (FF)

1. Figure 2 of Jasperson is reproduced below



“FIG. 2 is a left side elevational view thereof, the right side being a mirror image of that shown” (Jasperson, Description).

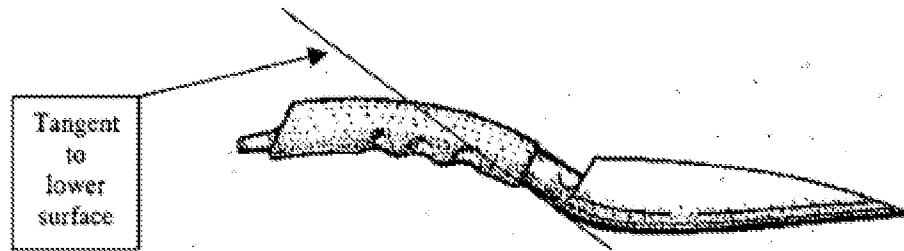
A. Discussion of the 35 U.S.C. § 102(b) rejection over Jasperson

Claim 20

In analyzing the claim language, we give claim phrases their broadest reasonable interpretation consistent with Appellants Specification. *See, e.g., In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000) (“[D]uring examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.”). The argued difference between claim 20 and Jasperson is whether Jasperson can reasonably be interpreted to teach “a

curved trowel blade having a lower surface tangent to a plane”, where the handle “intersects and extends beyond the plane tangent to the blade” (Claim 20).

We agree with the Examiner that the broadest interpretation of the phrase “a lower surface tangent to a plane” encompasses any lower surface of the trowel blade, including that chosen by the Examiner (*see* Ans. 6). The use of the open “a lower surface” is reasonably interpreted as including any lower surface at all, and does not reasonably imply any limitation to “the lowest surface” or to “surfaces which have the longest region contiguous with the tangent”. The Examiner shows a plane which is tangent to “a lower surface” of the trowel blade as reproduced below.



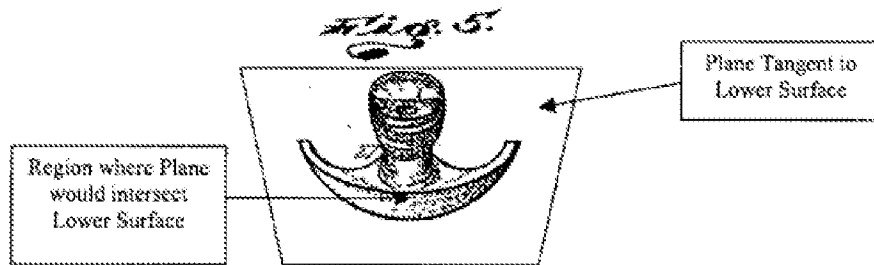
The Examiner’s drawing shows figure 2 of Jasperson with a line representing a plane which intersects the handle and which is tangent to a lower surface of the trowel blade (*see* Ans. 5-6). The tangent plane identified by the Examiner is one of many which could be drawn on the trowel blade of Jasperson which would satisfy the requirements of claim 20 using the broadest reasonable interpretation of “a lower surface” as discussed above. We note that the Specification does not provide any enlightenment on the requirement of the

tangent relative to “a lower surface”, not even mentioning the word tangent (*see* Spec. 1-8).

We are not persuaded by Appellant’s argument that “this drawing ‘is the only *reasonable* interpretation of this limitation’” (App. Br. 3). In fact, we find that any tangent to any lower surface of the trowel blade would be a reasonable interpretation of the claim limitation for a “blade having *a* lower surface tangent to a plane” (Claim 20, emphasis added). The ordinary understanding of the indefinite article “a” relative to the “lower surface” is that any lower surface is included.

We are not persuaded by Appellant’s argument that “[t]o be consistent, the Examiner must be able to draw his proposed line on *every view* of the cited reference. This is impossible because the Examiner’s interpretation of Appellant’s claim language is unorthodox” (App. Br. 5). Appellant does not cite any source for the requirement that the Examiner must be able to draw the line on every view of the cited reference. *See In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974). (“Attorney’s argument in a brief cannot take the place of evidence.”).

In our opinion, this asserted requirement would clearly be impossible in figure 1 of Jasperson, which does not show the bottom of the trowel blade at all. We agree with the Examiner, who states “[i]t is not a requirement for a claim to be anticipated by prior art for such a condition to exist. None the less, such an angled plane could be drawn as in the below attached figure” (Ans. 7).



The Examiner's drawing shows Figure 5 of Jasperson with a plane which is tangent to a lower surface of the trowel blade and which intersects the handle (*see* Ans. 7).

Appellant then contends that “[t]he tool of Jasperson is conventional. The handle is nearly straight. As such, a user would have to grip it in a conventional manner, with a bent wrist outside the wrist-neutral position” (App. Br. 6). However, there is no limitation in claim 20 regarding the manner of gripping the tool to which this argument is addressed. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (“although the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments”). Also *See In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004) (“Absent claim language carrying a narrow meaning, the PTO should only limit the claim based on the specification or prosecution history when those sources expressly disclaim the broader definition”).

Claim 31

We are not persuaded by Appellant's argument that “[t]he handle of Jasperson can only be held with a bent wrist, creating the very problem that Appellant's design avoids” (App. Br. 6). The specific limitation in claim 31

is that “the gripping section allows a user to hold the tool in a wrist-neutral position with a user’s forearm aligned along the line of attack” (Claim 31).

We reject Appellant’s argument that the intended use in claim 31 differentiates the claimed invention from Jasperson (*see* App. Br. 7). In *Sullivan*, the “applicant conceded that his composition was distinguished from the composition disclosed in a prior art patent only by the statement of intended use. Our predecessor court held that that intended use for the known composition could not render the claim patentable”. *In re Sullivan*, 498 F.3d 1345, 1353 (Fed. Cir. 2007). Here, the difference between the Jasperson trowel and the claimed trowel is a difference in intended use (*see* App. Br. 6). We conclude that this difference in intended use does not render a claim that is otherwise anticipated patentable.

We affirm the rejection of claims 20 and 31 under 35 U.S.C. § 102(b) over Jasperson. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejection of claim 21 as this claim was not argued separately.

B. 35 U.S.C. § 103(a) rejection over Jasperson

The Examiner relies on Jasperson as discussed above. The Examiner argues regarding claims 22 and 23 that “[i]t would have been obvious to . . . have modified the device in the claimed manner since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art” (Ans. 4).

The Examiner argues regarding claims 24 and 25 that “[i]t would have been an obvious matter of design choice to make the different portions of the device of whatever form or shape was desired or expedient” (Ans. 5).

Regarding claim 30, the Examiner “serves Official Notice that it is old and well known in the art of handles to use such covers for the purpose of improved gripping and comfort” (Ans. 5).

Appellant argues regarding claims 22-25 that “Appellant did achieve an unexpected result - namely, the ability to use the tool in a wrist-neutral position” (App. Br. 8). Appellant further contends regarding claim 30 that the Examiner relies “on Official Notice, since Jasperson does not teach the claim limitation. Second, since this [claim] carries with it all of the limitations of the claim from which it depends, and since Jasperson does not teach or suggest all of the limitations in combination, *prima facie* obviousness has not been established” (App. Br. 8).

B. Discussion of the 35 U.S.C. § 103(a) rejection over Jasperson

Claims 22-25

In *KSR*, the Supreme Court reasoned that

The principles underlying these cases are instructive when the question is whether a patent claiming the combination of elements of prior art is obvious. When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability.

KSR v. Teleflex Inc., 127 S. Ct. 1727, 1740 (2007). Applying the *KSR* standard of obviousness to claims 22-25, we conclude that the modification of the Jasperson trowel with the specific radius and circumference of claims 22 and 23, and the slight taper and ellipsis of claims 24 and 25 represents a combination of known elements which yield the predictable result of slightly different trowel configurations. Such a combination is merely a “predictable

use of prior art elements according to their established functions.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727 (2007).

We are not persuaded by Appellant’s contention that the alterations in claims 22-25 “achieve an unexpected result - namely, the ability to use the tool in a wrist-neutral position” (App. Br. 8). In our opinion, no unexpected results have been presented. “It is well settled that unexpected results must be established by factual evidence. Mere argument or conclusory statements in the specification does not suffice.” *In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984). Further, “[A]rguments of counsel cannot take the place of evidence lacking in the record.” *Estee Lauder Inc. v. L’Oreal, S.A.*, 129 F.3d 588, 595 (Fed. Cir. 1997) *quoting Knorr v. Pearson*, 671 F.2d 1368, 1373 (CCPA 1982). *See also, In re Lindner*, 457 F.2d 506, 508 (CCPA 1972) (“mere lawyers’ arguments unsupported by factual evidence are insufficient”).

Claim 30

We agree that an Examiner “may take notice of facts beyond the record which, while not generally notorious, are capable of such instant and unquestionable demonstration as to defy dispute.” *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970). Appellant does not contend that polymeric coverings on handles are not well known and appropriate for official notice, only that Jasperson does not teach “all of the limitations of the claim from which it depends” (App. Br. 8). Since we have already concluded that claim 20 is anticipated by Jasperson, we agree with the Examiner that Jasperson teaches all of the limitations of the claim from which claim 30 depends. Thus, the only question is whether Appellant has traversed the specific

Official Notice regarding handles with polymeric coverings. We conclude that Appellant's traversal is with regard to the elements found in claim 20, not the specific element of polymeric coverings added in claim 30, which is the claim at issue.

We affirm the rejection of claims 22-25 and 30 under 35 U.S.C. § 103(a) over Jasperson.

CONCLUSION

In summary, we affirm the rejection of claims 20 and 31 under 35 U.S.C. § 102(b) over Jasperson. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejection of claim 21 as this claim was not argued separately.

We affirm the rejection of claims 22-25 and 30 under 35 U.S.C. § 103(a) over Jasperson.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED

Ssc:

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